

REMARKS

Applicant respectfully requests entry of the following amendments and remarks in response to the Office Action mailed October 15, 2008. Applicant respectfully submits that the amendments and remarks contained herein place the instant application in condition for allowance.

Upon entry of the amendments in this response, claims 1 – 21 and 23 are pending. In particular, Applicant adds claim 23, amends claims 1 – 2, 4 – 5, 7 – 11, 16 – 20, and cancels claim 22 without prejudice, waiver, or disclaimer. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

I. Examiner Interview

Applicant first wishes to express sincere appreciation for the time that Examiner Hussain spent with Applicant's Attorney, Anthony Bonner, during a telephone discussion on November 24, 2008 regarding the outstanding Office Action. During that conversation, Examiner Hussain and Mr. Bonner discussed potential arguments and amendments with regard to claim 1, in view of *Lee* and *Fostick*. The general thrust of the potential principal arguments included a discussion of at least one embodiment of the present application disclosing "prompting the sender to forward the instant message from the first recipient to a second recipient and indicate, by the first recipient, that the IM message originated from the sender." Thus, Applicant respectfully requests that Examiner Hussain carefully consider this response and the amendments.

II. Rejections Under 35 U.S.C. §101

The Office Action rejects claim 19 is rejected as allegedly being directed to non-statutory subject matter. Applicant refreshes the arguments presented in the response filed June 30, 2008, but amends claim 19 to expedite allowance of the present application.

III. Rejections Under 35 U.S.C. §112, First Paragraph

The Office Action rejects claim 19 as allegedly failing to comply with the written description requirement. Applicant refreshes the arguments presented in the response filed June 30, 2008, but amends claim 19 to expedite allowance of the present application.

IV. Rejections Under 35 U.S.C. §103

A. Claim 1 is Allowable Over *Lee* in view of *Fostick*

The Office Action indicates that claim 1 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Number 2003/0233265 ("*Lee*") in view of U.S. Patent Publication Number 2002/0187794 ("*Fostick*"). Applicant respectfully traverses this rejection for at least the reason that *Lee* in view of *Fostick* fails to disclose, teach, or suggest all of the elements of claim 1. More specifically, claim 1 recites:

A communication method comprising:
receiving an instant messaging (IM) message from a sender to a first recipient;
waiting a predefined time interval for an input from the first recipient, the input being responsive to the IM message;
determining whether input from the first recipient is received during the predetermined time interval; and
in response to determining that no input from the first recipient is received during the predetermined time interval, ***prompting the sender to forward the instant message from the first recipient to a second recipient and indicate, by the first recipient, that the IM message originated from the sender.***

(Emphasis added).

Applicant respectfully submits that claim 1, as amended, is allowable over the cited art for at least the reason that neither *Lee* nor *Fostick*, taken alone and in combination, discloses, teaches, or suggests a "communication method comprising... in response to determining that no input from the first recipient is received during the predetermined time interval, ***prompting the sender to forward the instant message from the first recipient to a second recipient and***

indicate, by the first recipient, that the IM message originated from the sender" as recited in claim 1, as amended. More specifically, while not explicit in the current Office Action, the Office Action dated March 31, 2008 admits that "Lee... is silent on disclosing explicitly, prompting the sender to send the instant message to a second recipient and indicating, by the first recipient that the IM message originated from the sender" (OA page 6, paragraph 11, line 16).

Additionally, *Fostick* fails to overcome the deficiencies of *Lee*. As previously argued, *Lee* discloses a:

[message recipient] sets up (1005) one or more automated response messages (ARM) on an [automated response message system]... The [message recipient] sets up such [automated response messages]... allowing [the message recipient] (12) to enter and confirm the [automated response message], or by sending at least one SMS message to the [automated response message system] (18). A message might say, for example, that 'I'm on vacation for the week, contact me May 1st', and the [message recipient] would send it to the phone number associated with the [automated response message system].

(page 3, paragraph [0040]).

As illustrated in this passage, *Fostick* appears to disclose that, if a message recipient is not available, the automated response message system can send a reply message back to the message sender, indicating the message recipient's unavailability. This is completely different than claim 1 for at least the reason that *Fostick* fails to even suggest prompting the message sender to do anything, not to mention prompting the sender to forward a message from the first recipient to the second recipient. For at least these reasons, claim 1 is allowable.

B. Claim 5 is Allowable Over *Lee* in view of *Fostick*

The Office Action indicates that claim 5 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Number 2003/0233265 ("*Lee*") in view of U.S. Patent Publication Number 2002/0187794 ("*Fostick*"). Applicant respectfully traverses this

rejection for at least the reason that *Lee* in view of *Fostick* fails to disclose, teach, or suggest all of the elements of claim 5. More specifically, claim 5 recites:

A communication method comprising:
receiving an instant messaging (IM) message from a first sender to a recipient;
determining whether input from the first recipient is received during a predetermined time interval;
in response to determining that no input is received during the predetermined time interval determining whether the first recipient is engaged in an IM chat session with a second sender;
and
in response to determining that the first recipient is engaged in an IM chat session with the second sender, ***prompting the sender to forward the instant message from the first recipient to a second recipient and indicating, by the first recipient, that the IM message originated from the sender.***

(Emphasis added).

Applicant respectfully submits that claim 5, as amended, is allowable over the cited art for at least the reason that neither *Lee* nor *Fostick*, taken alone and in combination, discloses, teaches, or suggests a “communication method comprising... in response to determining that the first recipient is engaged in an IM chat session with the second sender, ***prompting the sender to forward the instant message from the first recipient to a second recipient and indicating, by the first recipient, that the IM message originated from the sender***” as recited in claim 5, as amended. More specifically, while not explicit in the current Office Action, the Office Action dated March 31, 2008 admits that “*Lee*... is silent on disclosing explicitly, prompting the sender to send the instant message to a second recipient and indicating, by the first recipient that the IM message originated from the sender” (OA page 6, paragraph 11, line 16).

Additionally, *Fostick* fails to overcome the deficiencies of *Lee*. As previously argued, *Lee* discloses a:

[message recipient] sets up (1005) one or more automated response messages (ARM) on an [automated response message system]... The [message recipient] sets up such [automated response messages]... allowing [the message recipient] (12) to

enter and confirm the [automated response message], or by sending at least one SMS message to the [automated response message system] (18). A message might say, for example, that 'I'm on vacation for the week, contact me May 1st', and the [message recipient] would send it to the phone number associated with the [automated response message system].

(page 3, paragraph [0040]).

As illustrated in this passage, *Fostick* appears to disclose that, if a message recipient is not available, the automated response message system can send a reply message back to the message sender, indicating the message recipient's unavailability. This is completely different than claim 5 for at least the reason that *Fostick* fails to even suggest prompting the message sender to do anything, not to mention prompting the sender to forward a message from the first recipient to the second recipient. For at least these reasons, claim 5 is allowable.

C. Claim 10 is Allowable Over *Lee* in view of *Fostick*

The Office Action indicates that claim 10 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Number 2003/0233265 ("*Lee*") in view of U.S. Patent Publication Number 2002/0187794 ("*Fostick*"). Applicant respectfully traverses this rejection for at least the reason that *Lee* in view of *Fostick* fails to disclose, teach, or suggest all of the elements of claim 10. More specifically, claim 10 recites:

A computer-readable medium encoded with a computer program such that when executed by a computer performs at least the following:

receive an instant messaging (IM) message from a sender to a first recipient;

wait a predefined time interval for an input from the first recipient, the input being responsive to the IM message;

determine whether input from the first recipient is received during the predetermined time interval; and

in response to determining that no input from the first recipient is received during the predetermined time interval, ***prompt the sender to forward the instant message from the first recipient to a second recipient and indicating, by the first recipient, that the IM message originated from the sender.***

(Emphasis added)

Applicant respectfully submits that claim 10, as amended, is allowable over the cited art for at least the reason that neither *Lee* nor *Fostick*, taken alone and in combination, discloses, teaches, or suggests a "computer-readable medium encoded with a computer program such that when executed by a computer performs at least the following... in response to determining that no input from the first recipient is received during the predetermined time interval, ***prompt the sender to forward the instant message from the first recipient to a second recipient and indicating, by the first recipient, that the IM message originated from the sender***" as recited in claim 10, as amended. More specifically, while not explicit in the current Office Action, the Office Action dated March 31, 2008 admits that "Lee... is silent on disclosing explicitly, prompting the sender to send the instant message to a second recipient and indicating, by the first recipient that the IM message originated from the sender" (OA page 6, paragraph 11, line 16).

Additionally, *Fostick* fails to overcome the deficiencies of *Lee*. As previously argued, *Lee* discloses a:

[message recipient] sets up (1005) one or more automated response messages (ARM) on an [automated response message system]... The [message recipient] sets up such [automated response messages]... allowing [the message recipient] (12) to enter and confirm the [automated response message], or by sending at least one SMS message to the [automated response message system] (18). A message might say, for example, that 'I'm on vacation for the week, contact me May 1st', and the [message recipient] would send it to the phone number associated with the [automated response message system].

(page 3, paragraph [0040]).

As illustrated in this passage, *Fostick* appears to disclose that, if a message recipient is not available, the automated response message system can send a reply message back to the message sender, indicating the message recipient's unavailability. This is completely different than claim 10 for at least the reason that *Fostick* fails to even suggest prompting the message

sender to do anything, not to mention prompting the sender to forward a message from the first recipient to the second recipient. For at least these reasons, claim 10 is allowable.

D. Claim 14 is Allowable Over *Lee* in view of *Fostick*

The Office Action indicates that claim 14 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Number 2003/0233265 ("*Lee*") in view of U.S. Patent Publication Number 2002/0187794 ("*Fostick*"). Applicant respectfully traverses this rejection for at least the reason that *Lee* in view of *Fostick* fails to disclose, teach, or suggest all of the elements of claim 14. More specifically, claim 14 recites:

A computer-readable medium encoded with a computer program such that when executed by a computer performs at least the following:

receive an instant messaging (IM) message from a first sender to a first recipient;

determine whether input from the first recipient is received during a predetermined time interval;

in response to determining that no input is received during the predetermined time interval, determine whether the first recipient is engaged in an IM chat session with second sender; and

in response to determining that the first recipient is engaged in an IM chat session with the second sender ***prompt the sender to forward the instant message from the first recipient to a second recipient and indicating, by the first recipient, that the IM message originated from the sender.***

(Emphasis added)

Applicant respectfully submits that claim 14, as amended, is allowable over the cited art for at least the reason that neither *Lee* nor *Fostick*, taken alone and in combination, discloses, teaches, or suggests a "computer-readable medium encoded with a computer program such that when executed by a computer performs at least the following... in response to determining that the first recipient is engaged in an IM chat session with the second sender ***prompt the sender to forward the instant message from the first recipient to a second recipient and indicating, by the first recipient, that the IM message originated from the sender***" as recited in claim 14, as amended. More specifically, while not explicit in the current Office

Action, the Office Action dated March 31, 2008 admits that “Lee... is silent on disclosing explicitly, prompting the sender to send the instant message to a second recipient and indicating, by the first recipient that the IM message originated from the sender” (OA page 6, paragraph 11, line 16).

Additionally, *Fostick* fails to overcome the deficiencies of *Lee*. As previously argued, *Lee* discloses a:

[message recipient] sets up (1005) one or more automated response messages (ARM) on an [automated response message system]... The [message recipient] sets up such [automated response messages]... allowing [the message recipient] (12) to enter and confirm the [automated response message], or by sending at least one SMS message to the [automated response message system] (18). A message might say, for example, that ‘I’m on vacation for the week, contact me May 1st’, and the [message recipient] would send it to the phone number associated with the [automated response message system].

(page 3, paragraph [0040]).

As illustrated in this passage, *Fostick* appears to disclose that, if a message recipient is not available, the automated response message system can send a reply message back to the message sender, indicating the message recipient’s unavailability. This is completely different than claim 14 for at least the reason that *Fostick* fails to even suggest prompting the message sender to do anything, not to mention prompting the sender to forward a message from the first recipient to the second recipient. For at least these reasons, claim 14 is allowable.

E. Claim 19 is Allowable Over Lee in view of Fostick

The Office Action indicates that claim 19 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Number 2003/0233265 (“*Lee*”) in view of U.S. Patent Publication Number 2002/0187794 (“*Fostick*”). Applicant respectfully traverses this rejection for at least the reason that *Lee* in view of *Fostick* fails to disclose, teach, or suggest all of the elements of claim 19. More specifically, claim 19 recites:

A communication system comprising:
means for receiving an instant messaging (IM) message from a sender to a first recipient;
means for determining whether the first recipient has provided an input during a predefined time interval;
means for, in response to determining that the first recipient has not provided an input during the predetermined time interval, determining whether the first recipient is engaged in an IM chat session with another sender;
means for, in response to determining that the first recipient is engaged in an IM chat session with another sender, replying to the IM message; and
means for, in response to determining that the first recipient is not engaged in an IM chat session with another user, ***prompting the sender to forward the instant message from the first recipient to a second recipient and indicate, by the first recipient, that the IM message originated from the sender,***
wherein all the means are embodied as hardware controlled by software.

(Emphasis added)

Applicant respectfully submits that claim 19, as amended, is allowable over the cited art for at least the reason that neither *Lee* nor *Fostick*, taken alone and in combination, discloses, teaches, or suggests a “communications system comprising... means for, in response to determining that the first recipient is not engaged in an IM chat session with another user, ***prompting the sender to forward the instant message from the first recipient to a second recipient and indicate, by the first recipient, that the IM message originated from the sender***” as recited in claim 19, as amended. More specifically, while not explicit in the current Office Action, the Office Action dated March 31, 2008 admits that “*Lee*... is silent on disclosing explicitly, prompting the sender to send the instant message to a second recipient and indicating, by the first recipient that the IM message originated from the sender” (OA page 6, paragraph 11, line 16).

Additionally, *Fostick* fails to overcome the deficiencies of *Lee*. As previously argued, *Lee* discloses a:

[message recipient] sets up (1005) one or more automated response messages (ARM) on an [automated response message system]... The [message recipient] sets up such [automated

response messages]... allowing [the message recipient] (12) to enter and confirm the [automated response message], or by sending at least one SMS message to the [automated response message system] (18). A message might say, for example, that 'I'm on vacation for the week, contact me May 1st', and the [message recipient] would send it to the phone number associated with the [automated response message system].

(page 3, paragraph [0040]).

As illustrated in this passage, *Fostick* appears to disclose that, if a message recipient is not available, the automated response message system can send a reply message back to the message sender, indicating the message recipient's unavailability. This is completely different than claim 19 for at least the reason that *Fostick* fails to even suggest prompting the message sender to do anything, not to mention prompting the sender to forward a message from the first recipient to the second recipient. For at least these reasons, claim 19 is allowable.

F. Claim 20 is Allowable Over *Lee* in view of *Fostick*

The Office Action indicates that claim 20 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Number 2003/0233265 ("*Lee*") in view of U.S. Patent Publication Number 2002/0187794 ("*Fostick*"). Applicant respectfully traverses this rejection for at least the reason that *Lee* in view of *Fostick* fails to disclose, teach, or suggest all of the elements of claim 20. More specifically, claim 20 recites:

A communication system comprising:
a memory component that stores:
instant-messaging (IM) receive logic configured to receive an IM message from a sender to a first recipient;
first determining logic configured to determine whether the first recipient has provided an input during a predefined time interval;
second determining logic configured to, in response to determining that the first recipient has not provided an input during the predetermined time interval, determine whether the first recipient is engaged in an IM chat session with another sender;
reply logic configured to, in response to determining that the first recipient is engaged in an IM chat session with another sender, reply to the IM message; and
prompting logic configured to, in response to determining that the first recipient is not engaged in an IM chat session with another sender, ***prompt the sender to forward the instant message from the first recipient to a second recipient and indicating, by the first recipient, that the IM message originated from the sender.***

(Emphasis added)

Applicant respectfully submits that claim 20, as amended, is allowable over the cited art for at least the reason that neither *Lee* nor *Fostick*, taken alone and in combination, discloses, teaches, or suggests a “communications system comprising... prompting logic configured to, in response to determining that the first recipient is not engaged in an IM chat session with another sender, ***prompt the sender to forward the instant message from the first recipient to a second recipient and indicating, by the first recipient, that the IM message originated from the sender***” as recited in claim 20, as amended. More specifically, while not explicit in the current Office Action, the Office Action dated March 31, 2008 admits that “Lee... is silent on disclosing explicitly, prompting the sender to send the instant message to a second recipient and indicating, by the first recipient that the IM message originated from the sender” (OA page 6, paragraph 11, line 16).

Additionally, *Fostick* fails to overcome the deficiencies of *Lee*. As previously argued, *Lee* discloses a:

[message recipient] sets up (1005) one or more automated response messages (ARM) on an [automated response message system]... The [message recipient] sets up such [automated

response messages]... allowing [the message recipient] (12) to enter and confirm the [automated response message], or by sending at least one SMS message to the [automated response message system] (18). A message might say, for example, that 'I'm on vacation for the week, contact me May 1st', and the [message recipient] would send it to the phone number associated with the [automated response message system].

(page 3, paragraph [0040]).

As illustrated in this passage, *Fostick* appears to disclose that, if a message recipient is not available, the automated response message system can send a reply message back to the message sender, indicating the message recipient's unavailability. This is completely different than claim 20 for at least the reason that *Fostick* fails to even suggest prompting the message sender to do anything, not to mention prompting the sender to forward a message from the first recipient to the second recipient. For at least these reasons, claim 20 is allowable.

G. Claims 2 – 3, 9, 11 – 12, and 18 are Allowable Over Lee in view of Fostick

The Office Action indicates that claims 2 – 3, 9, 11 – 12, and 18 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable U.S. Patent Number 2003/0233265 ("*Lee*") in view of U.S. Patent Publication Number 2002/0187794 ("*Fostick*"). Applicant respectfully traverses this rejection for at least the reason that *Lee* in view of *Fostick* fails to disclose, teach, or suggest all of the elements of claims 2 – 3, 9, 11 – 12, and 18. More specifically, dependent claims 2 – 3 are believed to be allowable for at least the reason that these claims depend from and include the elements of allowable independent claim 1. Dependent claim 9 is believed to be allowable for at least the reason that this claim depends from and includes the elements of allowable independent claim 5. Dependent claims 11 – 12 are believed to be allowable for at least the reason that they depend from and include the elements of allowable independent claim 10. Dependent claim 18 is believed to be allowable for at least the reason that this claim depends from and includes the elements of allowable independent claim 14. Further, dependent claim 22 is believed to be allowable for at least the reason that this claim depends

from and includes the elements of allowable independent claim 20. Because *Fostick* fails to overcome the deficiencies of *Lee*, claims 2 – 3, 9, 11 – 12, and 18 are allowable as a matter of law. *In re Fine, Minnesota Mining and Mfg.Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

H. Claims 4, 8, 13, and 17 are Allowable Over *Lee* and *Fostick* in view of *Murphy*

The Office Action indicates that claims 4, 8, 13, and 17 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable U.S. Patent Number 2003/0233265 ("*Lee*") and U.S. Patent Publication Number 2002/0187794 ("*Fostick*") in view of U.S. Patent Publication Number 2007/0274497 ("*Murphy*"). Applicant respectfully traverses this rejection for at least the reason that *Lee* and *Fostick* in view of *Murphy* fails to disclose, teach, or suggest all of the elements of claims 4, 8, 13, and 17. Dependent claim 4 is believed to be allowable for at least the reason that this claim depends from and includes the elements of allowable independent claim 1. Dependent claim 8 is believed to be allowable for at least the reason that this claim depends from and includes the elements of allowable independent claim 5. Dependent claim 13 is believed to be allowable for at least the reason that this claim depends from and includes the elements of allowable independent claim 10. Dependent claim 17 is believed to be allowable for at least the reason that this claim depends from and includes the elements of allowable independent claim 14. Because *Fostick* and *Murphy* fail to overcome the deficiencies of *Lee*, claims 4, 8, 13, and 17 are allowable as a matter of law. *In re Fine, Minnesota Mining and Mfg.Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

V. New Claim 22 is Allowable

In addition, new claim 22 is allowable as a matter of law for at least the reason that this claim depends from allowable independent claim 20. *In re Fine, Minnesota Mining and Mfg.Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002). Support for this claim may be found, among other places on page 21, last line.

CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, all objections and/or rejections have been traversed, rendered moot, and/or addressed, and that the now pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested.

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and Official Notice, or statements interpreted similarly, should not be considered well-known for the particular and specific reasons that the claimed combinations are too complex to support such conclusions and because the Office Action does not include specific findings predicated on sound technical and scientific reasoning to support such conclusions.

If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

/afb/

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